THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CAROLYN JEAN CUPP,
LYNN ANN GERHEART, SCOTT SCHNELL,
SHERI LYNN SMITHEY and DONNA ELIZABETH ANDERSON

Appeal No. 2002-1011
Application No. 09/154,646

HEARD: January 07, 2003

Before WALTZ, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

ON REMAND TO THE EXAMINER

This appeal was taken pursuant to 35 U.S.C. § 134 from the final rejection of claims 1-20 and 24.

Our review of the application leads us to conclude that this appeal is not in condition for a decision at this time.

Therefore, we remand the application to the examiner to consider the following issues and to take appropriate action.

Appellants filed a reply brief on October 05, 2001 (Paper No. 17). The examiner noted that the Reply Brief had been entered and considered and forwarded the application to the Board. See Paper No. 19. Our review of the record reveals that the examiner has not indicated whether the evidence (excerpt from Technology of Cereals, a textbook by N. L. Kent and A. D. Evers) furnished by appellants with the reply brief for further arguing against the examiner's rejection of independent claim 8 and the claims which depend therefrom was entered or not. We decline to speculate regarding that matter. See 37 CFR § 1.195.

In addition, in the answer, the examiner maintained a rejection of claims 1-20 and 24 under 35 U.S.C. § 102 as anticipated by Simone et al. (U.S. Pat. No. 5,407,661). In applying that patent as an anticipatory reference, the examiner maintains the position that a reference term "about 10 to about 30% by weight" (column 5, lines 65-68) in describing moisture levels meets the claimed limitation of "a moisture content of less than 10% by weight" for the pet food product. See, e.g., claim 1 and pages 4 and 5 of the answer.

It is important that the examiner conducts a complete examination of the claimed subject matter with respect to prior art references that are found to be particularly relevant according to the examiner not only under 35 U.S.C. § 102 but also under 35 U.S.C. § 103. Where overlapping ranges are involved, as is the case here, the examiner should consider the patentability of the claims under § 103. See Ex parte Lee, 31 USPQ2d 1105, 1107 (Bd. Pat. App. & Int. 1993) ("We understand that alternative grounds of rejection under 35 U.S.C. 102 and 103 are conventionally relied on by examiners in the event that they should be found to have erred in their conclusion that the claimed invention was actually described in a single reference as required by 35 U.S.C. 102. We consider this practice to be prudent and encourage it"). More particularly, the predecessor of our reviewing court has found obvious a claimed process wherein a claimed range therein abutted a prior art disclosed range that had an endpoint characterized by the term "about." See In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) (a prior art patent taught a maximum CO concentration of 5%, while appellant's claim required a CO concentration of "more than 5%").

In light of the above, we strongly encourage the examiner to also consider whether or not prosecution should be reopened to introduce a rejection of any of appellants' claims under 35 U.S.C. § 103 over Simone et al. alone or in combination with any other pertinent prior art the examiner may be aware of so that examination of appellants' claims is not conducted on a piecemeal basis.

Under the circumstances recounted above, the record before us is not in a condition which permits a proper disposition of the subject appeal. We are constrained, therefore, to remand this application for clarification of the file record with respect to the entry status of the exhibits accompanying the reply brief and their effect on any of the rejection(s) previously advanced by the examiner. While we authorize a supplemental answer under 37 CFR § 1.193(b)(1)(1999) for the examiner to effect that clarification and to respond to the reply brief, we also encourage the examiner to reconsider the claimed subject matter in light of the above discussion and reopen prosecution to enter any new grounds of rejection that may also be applicable as an alternative to submitting a supplemental

answer if the examiner considers such to result in a more appropriate and complete action.

This application, by virtue of its "special" status requires an immediate action. Manual of Patent Examining Procedure § 708.01 (8th ed., August 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

THOMAS A. WALTZ)
Administrative Patent Judge)
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PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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JEFFREY T. SMITH)
Administrative Patent Judge)

PFK:psb

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